

REMARKS

This paper addresses the most recent Office action, which is non-final.

Alleged indefiniteness

Claims 1, 30 and 47-48 are rejected under 35 USC 112, second paragraph, as being indefinite as a result of the “second transaction code” limitation. With respect, this rejection is traversed.

The Examiner questioned the meaning of “second transaction code” and, in particular, where the code “comes from” as well as its “relationship with other limitation[s].” With respect, the Examiner concerns, however, are unfounded, as the claim language itself was very clear and unambiguous. There is no requirement under Section 112(2) that a patent claim include each and every structural and functional feature associated with a particular implementation. Thus, for example, it is sufficient to say that a “first transaction code” is scanned, and then a “second transaction code” is scanned without further requiring that the claims recite each and every detail about those codes such as how they may be different, where they originate, and so forth.

Nevertheless, to advance this prosecution, claim 1 has been amended to positively recite the step of “receiving over the wireless communication link, by the wireless communication device, a second transaction code capable of being optically scanned.” Amended claim 1 now recites a first transaction code, and a second transaction code, and it further recites that each of the codes is received by the wireless communication device.” Section 112(2) requires nothing more.

The rejection is moot with respect to claims 30 and 47-48, as the “second transaction code” limitation has been omitted, as it is not necessary to distinguish over the prior art of record.

The Examiner is requested to withdraw this rejection with respect to amended claim 1.

Alleged obviousness

Claims 1-3, 5-12, 14-25, 30, 34, 36-37, 40-43, 47-49 and 51-53 are rejected under 35 USC 103(a) as being unpatentable over Lewis, U.S. Publication No. 2003/0105641, in view of Hymel, WO 00/03328, further in view of Melick, U.S. Publication No. 2007/0246538.

Claims 26-29, and 31-33 are rejected under 35 USC 103(a) as being unpatentable over Lewis, Hymel and Melick, further in view of Ulvinen, U.S. Patent No. 6,393,305.

With respect, each of these rejections is traversed.

Lewis teaches a system whereby an end user navigates to a web site from his/her desktop computer (Figure 1) or mobile phone (Figure 7), purchases a ticket, and then receives the ticket, possibly in the form of a UPC-type code that can be scanned from at a reader device at a point of entry to the event associated with the ticket.

Hymel describes a system whereby a pager device can be used to receive and store UPC-type code that can represent a product coupon. That coupon can be scanned from the pager at the point-of-sale.

Melick describes a bar code reader that reads 1D and 2D bar code formats from a paper source or the like, but not from the face of a mobile device.

The Examiner is reminded that it is first necessary to construe the pertinent claim language, as claim construction must always precede the question of whether the claim, as properly construed, is anticipated or obvious. *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003).

Turning first to independent claim 30, the subject matter of this disclosure concerns a “wireless transaction” that has been defined within the claim itself as follows:

“a wireless transaction that begins with a purchase action with respect to a product or service, and that concludes with a multi-stage fulfillment action associated with the purchase action, the fulfillment action including personal bodily entry into or through a physical structure using the wireless communication device.”

Independent claim 47 self-defines the “wireless transaction” as follows:

“a wireless transaction defined by an authorization with respect to a product or service, and a multi-stage fulfillment action associated with the authorization, the fulfillment action including personal bodily access into a physical location or structure using the wireless communication device.”

Independent claim 48 self-defines the “wireless transaction” as follows:

“a wireless transaction consisting essentially of an authorization with respect to a product or service, and a multi-stage fulfillment event associated with the authorization, the fulfillment event occurring at a fulfillment location using the wireless communication device.”

Moreover, the “multi-stage fulfillment” recited in each of these claims is tied specifically with other claim language in that the wireless transaction is only “partially complete” (at a “second time” after the transaction code is optically scanned) and then, subsequently, “complete” (at the “third time distinct from the first time and the second time”) after the transaction code is optically scanned again.

In Lewis, the transaction is not “partially complete” and then later “complete” as a transaction code is scanned from the device. Rather, the code is provided to the device and scanned, and then the transaction is over.

In Hymel, at most there are a series of sequential “transactions” (a coupon is displayed and then redeemed) but, importantly, each such transaction is completely independent of every other one. There is no transaction that can be said to be “partially complete” and then “complete” in the manner positively recited by, for example, claim 30. Indeed, because every coupon transaction is independent of every other one, there is never any multi-stage fulfillment action as positively recited.

Here, the “combined teachings” of Lewis, Hymel and Melick describe a system whereby an end user navigates to a web site, purchases a ticket, receives the ticket (that includes a UPC or 2D code) at his/her device or pager, and then presents the code to be scanned from a reader device at a point of entry to the event associated with the ticket. *There is just one scan*. Once this scan occurs and the individual enters the event, *the individual transaction is over*. Hymel, at best, suggests that the process can be repeated again – but only with respect to a different transaction.

Lewis teaches only a single scan; the described Lewis scan does not “partially complete” a transaction that is later “complete[d]” by a second scan.

“[E]very limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines.” *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970); *See also In re Wilson*, 424 F. 2d 1382, 1385 (CCPA 1970) (“[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”). Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner may not “resort to speculation, unfounded

assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 10100, 1017 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Here, the combined teachings in Lewis, Hymel and Melick fail to disclose or suggest the “wireless transaction” as positively recited. With respect, the Examiner’s conclusion to the contrary is impermissible hindsight. See, *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (The fact finder must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning”; citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a “temptation to read into the prior art the teachings of the invention in issue.”)).

Moreover, the Examiner also continues to ignore important evidence that points away from the conclusion of alleged obviousness. The Mamdani declaration was made of record on February 13, 2009, in response to a prior Office action rejection based on Lewis and Hymel (cited currently) and a third reference, Whitworth (U.S. Publication No. 20010034717), which the Examiner had contended taught the “2D image code” aspect of the claims. In response to that earlier rejection, the Applicants submitted the Mamdani declaration to explain why 2D bar codes (such as described in Whitworth) would not have been used to facilitate complex wireless transactions at the time of the invention. In particular, Mr. Mamdani pointed out that, because of the inherent limitations of mobile devices, mobile device operating systems, and mobile web browser designs, at the time of the invention one of ordinary skill in the pertinent art would not have used 2D image codes for scanning from a wireless device, such as the Lewis PDA or the Hymel pager. (Mamdani Declaration, at paragraph 8).

The Examiner accepted Mr. Mamdani’s argument because in the very next Office action (mailed July 20, 2009), the following paragraph was stated: “Examiner has [] considered the Rule 132 Declaration of Malik Mamdani that was submitted with the communication of February 15, 2009. Whitworth is removed from the Office action.” (Office action, July 20, 2009, emphasis supplied).

Nevertheless, in the rejection here, the claims are rejected under the Lewis/Hymel/Melick combination, where Melick is cited solely for its teaching of a 2D bar code. In other words, the Examiner has simply substituted another “2D code” teaching – Melick – for the prior Whitworth

teaching which taught the same subject matter. The rejection, however, ignores the Mamdani declaration evidence that one of ordinary skill would not have made the Lewis/Hymel/2D bar code combination at the time of this invention. Indeed, the Examiner has not only ignored the Mamdani declaration in this regard, he has ignored his own prior action (in the Office action mailed July 20, 2009) whereby he “removed” Whitworth from the combination after consideration of that declaration. These inconsistent positions are irreconcilable.

In addition, Mr. Mamdani’s declaration also explains that the subject matter of amended claims 1, 30 and 47-48 (use of a 2D image code to facilitate a complex wireless transaction where a first scan “partially” completes the wireless transaction and the second scan then completes that transaction) has been commercially successful. There is no indication that the Examiner has ever considered this evidence, which is of record and should be evaluated as a “secondary consideration” that is probative of non-obviousness if and when the Examiner makes out a prima facie case, which (for the reasons noted above) he has not done.

For the reasons set forth above, a prima facie case of obviousness has not been made out.

Nothing herein shall be deemed an admission regarding the Examiner’s factual findings or conclusions including, without limitation, the findings and conclusions regarding each dependent claim. Nevertheless, separate arguments regarding the dependent claims are considered unnecessary at this time due to the deficiencies noted above. Applicant reserves the right to distinguish the Examiner’s findings and conclusions regarding these other claims in any future communication regarding this matter.

A Notice of Allowance is requested.

Respectfully submitted,

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